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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,843	12/27/2001	Terukazu Yanagi	Q67605	9834

7590 12/12/2003

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2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3213

EXAMINER

MONDESI, ROBERT B

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 12/12/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/026,843

Applicant(s)

YANAGI ET AL.

Examiner

Robert B Mondesi

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on December 5, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 3-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Amendment in response to election of restrictions*

Applicant's election with traverse of Invention I, Claims 1-2 in amendment, filed July 7, 2003 is acknowledged. The traversal is on the ground(s) the claims of Group II are directed to a silver halide color photographic sensitive material that contains the gelatin of the invention of Group I and therefore the scope of the claims of Group II are covered by the claims of Group I. This is not found persuasive because the original restriction was based on the fact that the inventions are related as mutually exclusive species in an intermediated and final product relationship. In such instance should the applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence, that is currently on record, showing the species to be obvious variants or clearly admit on the record that this is the case. Therefore the requirement is still deemed proper and is made FINAL. **Claims 3-16** are withdrawn from further consideration by the Examiner because these Claims are drawn to non-elected inventions

### *Priority*

The current application filed on December 27, 2003 claims priority to foreign applications; JAPAN NO. 2001-310289 filed on October 5, 2000, JAPAN NO. 2001-102468 filed on March 30, 2001, JAPAN NO. 2001-078191 filed on March 19, 2001 JAPAN NO. 2001-397237 filed on December 27, 2003 . A certified translation of foreign documents; JAPAN NO. 2001-310289 filed on October 5, 2000, JAPAN NO. 2001-

102468 filed on March 30, 2001, JAPAN NO. 2001-078191 filed on March 19, 2001  
JAPAN NO. 2001-397237 filed on December 27, 2003 has not been provided.

***Preliminary Amendment***

The preliminary amendment filed August 26, 2002 has been entered.

***Information Disclosure Statement***

The IDS filed September 24, 2002 has been received and is signed and considered, a copy of the IDS is attached to the following document.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1 and 2** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claim 1** the identifier "a" is missing before the word covalent (line 3).

In **claims 1 and 2** the phrase "introduction amount" is indefinite. In their current format, in **claims 1 and 2**, the use of the phrase "introduction amount" insinuates that the current stated amount of compound B used in the reaction is a beginning amount. If this is true then the amount stated would be the lower end of the amount of compound B required to perform the modification of gelatin. The question remains as to what is the upper end of the amount of compound B that is required in order to perform the modification reaction.

**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-2** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The peptide of the invention resemble naturally occurring gelatin, therefore they it does not constitute patentable subject matter. Insertion of "isolated and purified" before peptide would cure the deficiency.

See *American Wood v. Fiber Disintegrating Co.*, 90 U. S. 566 (1974); *American Fruit Growers v. Brogdex Co.*, 283 U. S. 1 (1931); *Funk Brothers Seed Co. v. Kalo Inoculant*, 33 U. S. 127 (1948); and *Diamond v. Chakrabarty*, 206 USPQ 193 (1980). See *American Wood v. Fiber Disintegrating Co.*, 90 U. S. 566 (1974); *American Fruit Growers v. Brogdex Co.*, 283 U. S. 1 (1931); *Funk Brothers Seed Co. v. Kalo Inoculant*, 33 U. S. 127 (1948); and *Diamond v. Chakrabarty*, 206 USPQ 193 (1980).

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 2** are rejected under 35 U.S.C. 102(b) as being anticipated by Miyake et al. US Patent 5,362,601. Miyake et al. disclose a composition that is obtained by reacting gelatin and a compound which contains a nitrogenous aromatic ring having

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a mercapto group and the amount of the compound used is between  $1.1 \times 10^{-6}$  mol to  $1.1 \times 10^{-3}$  mol per 100g of gelatin (table 3, emulsion 1-3) (**present claims 1-2**). Thus Miyake et al. teach all the elements of **claims 1-2** and these claims are anticipated under 35 USC 102(b).

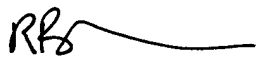
**Conclusion**


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B Mondesi whose telephone number is 703-305-4445. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 703-308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0198.

  
Robert B Mondesi  
Patent Examiner  
Group 1653  
12-10-03

  
ROBERT A. WAX  
PRIMARY EXAMINER